

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSELL P. RICH

Application No. 09/134,453

ORDER RETURNING UNDOCKETED APPEAL

This application was received at the Board of Patent Appeals and Interferences on June 15, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith returned to the examiner. The matters requiring attention prior to docketing are identified below.

On May 10, 2001, an Information Disclosure Statement (IDS) (Paper No. 8) was filed. According to the Advisory Action mailed August 14, 2001 (Paper No. 10), the IDS was considered. However, a copy of the IDS appears to be missing from the application file.

On November 19, 2002, an Examiner's Answer (Paper No. 29) was mailed "in response to the appeal brief filed October 28, 2002 [Paper No. 28].) However, an examination of the file reveals that the above-noted Appeal Brief appears to be missing from the application file. The Appeal Brief filed August 19, 2002 (Paper No. 26) also appears to be missing from the file.

An amendment after final filed was filed on May 8, 2002 (Paper No. 19). According to the Advisory Action mailed May 14, 2003 (Paper No. 20), "the proposed amendment(s) will not be entered because they are not deemed to place the application in better form for appeal. . . ." (Emphasis added). It should be noted that a second box was checked which stated "the proposed amendment will be entered. . . ." (Emphasis added). Clarification is required regarding the status of this amendment. If the amendment is to be entered, physical entry of the amendment is required.

An amendment after final was filed on June 24, 2002 (Paper No. 23). According to the Advisory Action mailed July 12, 2003 (Paper No. 24), "the proposed amendment(s) will be entered."

A review of the record indicates the amendment was not physically entered. Correction is required.

Lastly, appellant filed a Reply Brief and a Request for an extension of time under § 1.136(a) of the Code of Federal Regulations (CFR) (2002) on April 25, 2003 (Paper Nos. 31 and 32). This Reply Brief is untimely filed. 37 CFR 1.193(b)(1) states:

Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner's answer. See § 1.136(b) for extensions of time for filing a reply brief in a patent application and § 1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding.

37 CFR § 1.136(b) states:

b) When a reply brief cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not affect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit to commence a civil action; § 1.645 for extensions of time in interference proceedings; § 1.550(c) for extensions of

time in ex parte reexamination proceedings; and § 1.956 for extensions of time in inter partes reexamination proceedings.

Since appellant filed his extension of time after the two month date of January 19, 2003, and under the wrong section of 37 CFR § 1.136, the Reply Brief is untimely filed. Accordingly, the examiner needs to inform appellant that the Reply Brief filed April 25, 2003 will not be entered.

Accordingly, it is

ORDERED that the application is returned to the examiner:

1. for completion of the record by adding a copy of the IDS filed May 10, 2001 (Paper No. 8) to the application file;
2. for completion of the record by adding copies of the August 19, 2002 (Paper No. 26) and October 29, 2002 (Paper No. 28) Appeals Briefs to the application file;
3. for clarification regarding the status of the amendment filed May 8, 2002 (Paper No. 19);
4. if appropriate, for physical entry of the amendment filed May 8, 2002 (Paper No. 19);
5. for physical entry of the amendment filed June 24, 2002 (Paper No. 23);

6. to indicate that the Reply Brief filed April 25, 2003 (Paper No. 32) is untimely filed;
7. for notification to appellant regarding the action taken; and
8. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
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By:



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